



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,527	05/10/2001	Yuesheng Li	10882-003	6771

20583 7590 09/25/2003
PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

3

EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/853,527

Applicant(s)
Li et al.

Examiner
J. Pasterczyk

Art Unit
1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1755

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a compound used as a catalyst and the method of making it, classified in class 502, subclass 159.
- II. Claim 11, drawn to a method of making polyethylene, classified in class 526, subclass 170.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product, such as a Ziegler-Natta, chromium oxide, or metallocene catalyst.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Charles Miller, Esq., on 8/14/01, a provisional election was made with traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1755

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The disclosure is objected to because of the following informalities: the incorrect spelling "olefine" is used throughout the specification.

Appropriate correction is required.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "Y" in claims 1 and 10 is used by the claims to mean "a methylene group," while the accepted meaning is "yttrium."

Further in all the claims, all claims must end with a period.

Further in claim 1, it is not clear how the complex can be polynuclear if both m and n may be zero; this seems to be internally inconsistent. In text l. 8, change "forming" to --form--. In l. 10 insert --a-- before "heterocyclic". In l. 11 delete "residual", and it is not clear to what "or a

Art Unit: 1755

mixture thereof" refers. It is also not clear what part of these "residual groups" are double bonded to the imine nitrogen atoms.

In claim 2 the only real additional limitation to claim 1 is that n is zero, but this again raises the question of how this complex can be polynuclear if one of the monomers is not present at all.

In claim 3, l. 2, "Y is CR_3R_4 ," is prolix since it does not further limit this claim, nor does the recitation from "Q is a . . ." further limit the claim; both should be deleted. In l. 3, change both instances of "is" to --are-- and change "forming" to --form--. The problem claim has with regard to how the cyclic divalent radicals bond to the diimine nitrogen atoms also occurs here.

In claim 4, l. 2, "Y is CR_3R_4 ," is again prolix, and in l. 3 change the first two instances of "is" to --are-- and "forming" to --form--.

In claim 5 the only further limitations on claim 1 are those on the values of m and n; all the rest is prolix and should be cancelled.

Claims 6-9 have the same problem with "is" as claim 3. Claim 6 has the same problem with "forming" as does claim 3. Claims 6-9 have the same problems with "Y is CR_3R_4 " as claim 3. Further in claim 6 delete the commas on each side of "or" in l. 3. Further in claim 8 "Q is a . . ." is prolix and should be deleted.

In claim 10, it is suggested that the two diketones on l. 4 be given Roman numerals and be referred to as such in l. 3. After each set of formulae ". . . have the same definition in claim 1" is prolix and should be cancelled. In the first line of (b), insert --a-- after "carrying out".

Art Unit: 1755

8. The claims are allowable over the prior art of record. None of the prior art fairly describes or teaches a polynuclear diimine nickel(II) complex of the claimed formula, "polynuclear" being considered to be a material limitation despite the concurrent small values that m and n may have as currently claimed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J. Pasterczyk

AU 1755

9/12/03



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700